

REMARKS

With the entry of the present amendment, claims 1-7 and 12-16 will be presented for examination in this patent application. Claims 8-11, drawn to a non-elected species, stand withdrawn from consideration under 37 CFR § 1.142(b).

Subject Matter Recited in Claims 12-15

The *Office Action Summary* indicates that claims 1-7 and 12-15 are rejected. However, there is no rejection of claims 12-15 stated in the *Detailed Action* on pages 2-7. There is, then, no basis in the record for concluding that the subject matter recited in claims 12-15 is anticipated or rendered obvious by the prior art of record.

Prior Art Rejection I

Claims 1, 3, 4 and 6 were rejected under 35 USC § 102(a & e) as being anticipated by US 6623378 B2 (Beach et al. '378). Applicant respectfully traverses this rejection insofar as it might be deemed applicable to any of claims 1-4, 6 and 12 as now presented.

As observed by the Examiner, the club head shown in Fig. 4 of Beach et al. '378 includes a metal component forming a face plate 12 and sole plate 32 and a resin component forming a crown of the club head body.

Without acquiescing in the rejection, Applicant has amended claim 1 to specify that the sole plate is gradually increased in the thickness towards the rear end thereof, whereby a maximum thickness T_r at the rear end is in a range of from 2.0 to 8.0 mm, and a minimum thickness T_f in a front end zone of the sole plate is in a range of from 1.0 to 3.0 mm. Applicant has amended claim 2 (from which claims 4 and 6 depend) so as to be an independent claim and to further require that the tubular part extend from the sole plate. Applicant has amended claim 3 so as to be an independent claim and to further specify that the resin component M2 is integrally provided with a tubular portion protruding into the hollow and forming a socket into which said tubular part of the hosel portion is inserted. Applicant has amended claims 4 and 6 to additionally depend from claim 12, which is now presented as an independent claim.

Applicant has carefully reviewed the disclosure in Beach et al. '378 and can find no disclosure or suggestion of the variation in the sole plate thickness recited in claim 1. As

described in the specification of this patent application, by increasing the thickness of the sole plate from front to rear, the location of the center of gravity of the club head is made advantageously deeper and lower.

The only part of the club head shown in Fig. 4 of Beach et al. that could be fairly characterized as a tubular part of a hosel is the part that extends from the top of the face plate 12. This part cannot be fairly characterized as extending from the sole plate, as is required by claim 2.

According to the teachings in Beach et al., the "tubular part" may be formed separately from the metal component and the resin component. There are, however, no teachings or suggestions in Beach et al. that the resin component is integrally provided with a tubular portion protruding into the hollow of the club head and forming a socket that receives the tubular part of the hosel portion, as required by claim 3.

In Beach et al., there is no disclosure or suggestion of a slot in the metal component along a front end of the sole plate, as required by claim 12.

In view of the foregoing observations, Applicant respectfully submits that Beach et al. '378 cannot properly serve as a basis for rejecting independent claims 1-3 and 12, or any of the claims dependent from claims 1-3 and 12, under 35 USC § 102.

Prior Art Rejection II

Claims 1, 3, 4 and 6 were rejected under 35 USC § 102(b) as being anticipated by US 2002/0187853 A1 (Beach et al. '853). Applicant respectfully traverses this rejection insofar as it might be deemed applicable to claims 1-4, 6 and 12 as now presented.

The disclosure in Beach et al. '853 is the same as the disclosure in Beach et al. '378. Beach et al. '853 therefore has the same deficiencies vis-à-vis Applicant's claims as those in Beach et al. '378 identified above.

In view of the foregoing observations, Applicant respectfully submits that Beach et al. '853 cannot properly serve as a basis for rejecting independent claims 1-3 and 12, or any of the claims dependent from claims 1-3 and 12, under 35 USC § 102.

Prior Art Rejection III

Claim 2 was rejected under 35 USC § 103(a) as being unpatentable over Beach et al. '378. Applicant respectfully traverses this rejection insofar as it might be deemed applicable to claim 2 as now presented.

As pointed out above, there is no disclosure or suggestion in Beach et al. '378 that can meet the requirements of claim 2.

The Examiner has not cited any evidence to support his statements that "The method of attachment bears no weight in attaining the final product" and "one having ordinary skill in the art would have found such method of attachment to be an obvious matter of design choice." Applicant submits that, without such evidence, the Examiner has not established a *prima facie* case of obviousness under 35 USC § 103.

In view of the foregoing observations, Applicant respectfully submits that Beach et al. '378 cannot properly serve as a basis for rejecting claim 2 under 35 USC § 103.

Prior Art Rejection IV

Claim 5 and 7 were rejected under 35 USC § 103(a) as being unpatentable over Beach et al. '378 in view of US 1269745 (Robertson). Applicant respectfully traverses this rejection insofar as it might be deemed applicable to claims 5 and 7 as now presented.

The Examiner concedes that Beach et al. does not offer disclosure that can meet the claimed requirement for a sole plate having a thickness that increases from front to rear. As a remedy for the deficiencies of the Beach et al. '378 disclosure vis-à-vis the requirements of Applicant's claims, the Examiner proposes a modification of the Beach et al. club head whereby it incorporates a sole plate that increases in thickness from front to rear. As a basis for making this modification, the Examiner cites the disclosure in Robertson of a club head fitted with a sole plate of varying thickness.

Applicant submits that the disclosure in Robertson of a varying thickness sole plate fastened by screws to the bottom of a solid wood club head would not find obvious application to a technologically advanced metal/resin club head such as the one disclosed by Beach et al. Certainly, there is no suggestion in Beach et al. '378 that features of solid wood club heads would be applicable to the hollow metal/resin club heads.

Moreover, even if the Beach et al. '378 club head were modified as proposed by the Examiner, the resulting club head would not meet the requirements for construction features recited in parent claims 2, 3 or 12, as pointed out above.

In view of the foregoing observations, Applicant respectfully submits that the disclosures in Beach et al. '378 and Robertson cannot properly serve as a basis for rejecting claims 5 and 7 under 35 USC § 103.

Prior Art Rejection V

Claim 2 was rejected under 35 USC § 103(a) as being unpatentable over Beach et al. '853. Applicant respectfully traverses this rejection insofar as it might be deemed applicable to claims 2 as now presented.

The rationale for traversing this rejection is the same as that presented in the discussion above of Prior Art Rejection III above.

Applicant respectfully submits that Beach et al. '853 cannot properly serve as a basis for rejecting claim 2 under 35 USC § 103.

Prior Art Rejection VI

Claim 5 and 7 were rejected under 35 USC § 103(a) as being unpatentable over Beach et al. '853 in view of US 1269745 (Robertson). Applicant respectfully traverses this rejection insofar as it might be deemed applicable to claims 5 and 7 as now presented.

The rationale for traversing this rejection is the same as that presented in the discussion above of Prior Art Rejection IV above.

Applicant respectfully submits that the disclosures in Beach et al. '853 and Robertson cannot properly serve as a basis for rejecting claims 5 and 7 under 35 USC § 103.

Claims to Non-Elected Embodiments

In the discussions above, Applicant has shown that claims 1, 2 and 3 are allowable. Claims 1, 2 and 3 are generic to all of the species claimed in this application, and claims 8-11, drawn to the non-elected species, include all of the limitations of claims 1-3. Accordingly, Applicant submits that claims 8-11 are allowable along with claims 1-3 under 37 CFR § 1.141(a).

Other Prior Art

Applicant has reviewed the other prior art cited by the Examiner. This prior art was not applied against Applicant's claims and does not warrant comment by Applicant.

Conclusion

In view of the observations and arguments presented herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections stated in the outstanding Office Action and recognize all of the claims in this application as allowable.

If unresolved matters remain in this application, the Examiner is invited to contact Frederick R. Handren, Reg. No. 32,874, at the telephone number provided below, so that these matters can be resolved expeditiously.

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Respectfully submitted,

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